Remarks

The Examiner rejected claims 13-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 95-99 of U.S. Patent No. 6,009,355 ("the '355 patent") in view of Love. In addition, the Examiner rejected the same claims under the same doctrine over claims 95-99 of the '355 patent in view of Hanson. Although applicants strongly disagree with the Examiner's position, to advance the prosecution of the application, applicants submit herewith a Terminal Disclaimer to overcome these rejections.

The Examiner also rejected claims 13-22 under 35 U.S.C. 102(e) as being anticipated by Hanson. In response, applicants have amended base claims 13 and 18. Claims 15, 16, 20 and 21 have also been amended to properly reference the amended base claims.

The claimed invention is directed to measuring certain usage of a vehicle component, e.g., engine, to determine whether maintenance or servicing of the engine is needed. In an illustrative embodiment of the invention, the maintenance is scheduled according to the cumulative duration of the tachometer reading above a predetermined RPM value. Each time when the tachometer exceeds the predetermined value, the duration of such an occurrence is recorded. The latter is added to a running sum to update the cumulative duration in question. When the cumulative duration exceeds a predetermined length, a maintenance alert is triggered, and a selectable option may be provided on a display in the vehicle. A selection of the option causes information about the alert to be provided, thereby facilitating servicing of the vehicle component.

Hanson is directed to a technique for monitoring a truck engine and controlling the temperature of a truck sleeper unit. In accordance with the Hanson technique, the engine of a truck is automatically started and stopped to conserve fuel while providing temperature control of the sleeper unit, and maintaining (i.e., preserving) the truck engine in a ready-to-start condition. At the outset, Hanson does not even apply to the claimed

invention which is directed to maintaining, i.e., "servicing" a vehicle component based on its usage, as amended claims 13 and 18 now recite.

Moreover, nowhere does Hanson teach or suggest determining a measure, which is "a function of at least a duration," and which indicates an extent of performance degradation of a vehicle component due to an operation of the vehicle, as amended claims 13 and 18 now also recite. *A fortiori*, Hanson fails to teach or suggest "adding the duration to a cumulative duration," and determining whether the cumulative duration exceeds a predetermined value," as amended claims 13 and 18 now further recite. In addition, Hanson fails to teach or suggest "providing an alert when the cumulative duration exceeds the predetermined value." By contrast, Hanson at best discloses an output to "a buzzer in the engine compartment which warns when an automatic engine start is going to be made to maintain [i.e., preserve] the engine in a ready-to-start condition." Column 4, lines 16-19 of Hanson. As such, the claimed invention is not anticipated by Hanson. Nor is it obvious from reading Hanson. Thus, amended claims 13 and 18, together with their dependent claims, are patentable over Hanson.

The Examiner further rejected claims 13 and 18 under 35 U.S.C. 102(e) as being anticipated by Love.

Love discloses a wear trend analysis technique for components of a dialysis machine, used as a substitute for the natural kidney functions of a human body to clean blood of the natural accumulation of bodily wastes. The disclosed technique involves a count of abnormal events which have occurred when the operating condition of the dialysis machine component under analysis exceeded a threshold. At the outset, Love does not even apply to the claimed invention which is directed to maintaining a vehicle component whose "performance degradation" is "due to an operation of the vehicle," as claims 13 and 18 recite, rather than cleaning blood of bodily wastes as in the Love dialysis machine.

Moreover, nowhere does Love teach or suggest determining a measure, which is

"a function of at least a duration," and which indicates an extent of performance degradation of a vehicle component due to an operation of the vehicle, as amended claims 13 and 18 now also recite. *A fortiori*, Love fails to teach or suggest "adding the duration to a cumulative duration," and determining whether the cumulative duration exceeds a predetermined value," as amended claims 13 and 18 now further recite. In addition, Love fails to teach or suggest "providing an alert when the cumulative duration exceeds the predetermined value." By contrast, Love at best discloses recording the time and date, not duration, of each abnormal event along with the fact of the occurrence of such abnormal event, and the Love wear trend analysis may involve "extrapolating the abnormal event count value and dates associated with the abnormal events to predict a date of failure." Col. 7, line 44 through col. 8, line 5 of Love.

In addition, the Examiner rejected claims 14-17 and 19-22 under 35 U.S.C. 103(a) as being obvious over Love in view of Hanson. In any event, these claims are patentable over Love in view of Hanson by virtue of their dependency from base claims 13 and 18, which are patentable for the reasons set forth above.

In view of the foregoing, each of claims, 13-22, as amended, is believed to be in condition for allowance. Accordingly, reconsideration of these claims is requested, and allowance of the application is earnestly solicited.

Supplemental Information Disclosure Statement

Applicants also submit herewith a Supplemental Information Disclosure Statement (IDS) by Applicant (1 page), listing additional references which are or may be material to the examination of the subject application. Copies of the additional references are enclosed. It is respectfully requested that they be made of record in the file history of the application.

Identification of references in the IDS is not to be construed as an admission by applicants or attorneys for applicants that such references are available as "prior art"

against the subject application. The right is reserved to antedate any listed reference in accordance with standard procedures.

In addition, applicants bring to the Examiner's attention Civil Action No. '04 CV 00614 DMS, which was brought by American Calcar Inc. against BMW of North America, LLC. before the United States District Court for the Southern District of California. This civil action is based on, among others, U.S. Patent No. 6,009,355 ("the '355 patent") issued on Application Serial No. 08/789,934 of which the present application claims priority. A copy of the cover page of the Complaint is enclosed for the PTO's records and file history of the present application. The names of the inventors of the '355 patent are Michael L. Obradovich, Michael L. Kent and John G. Dinkel. American Calcar Inc. is a Delaware corporation with its principal place of business at 1001 Avenida Pico C139, San Clemente, California. BMW of North America, LLC is a New Jersey limited liability company with its principal place of business at 300 Chestnut Ridge Road, Woodcliff Lake, New Jersey.

The required fee $180 for filing the IDS is also enclosed, along with $55 for filing the Terminal Disclaimer.

Respectfully,

By 

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Date: September 13, 2004
Enclosures

COPY

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IN THE UNITED STATES DISTRICT COURT

FOR THE SOUTHERN DISTRICT OF CALIFORNIA

AMERICAN CALCAR INC., a Delaware corporation, Plaintiff, v. BMW OF NORTH AMERICA, LLC, a New Jersey limited liability company, Defendant.	Civil Action No. '04 CV 0061 4 DMS (LSP) **COMPLAINT FOR INFRINGEMENT OF U.S. PATENT NOS. 6,009,355; 6,148,261; 6,275,231; 6,282,464; 6,330,497; 6,438,465; 6,459,961; 6,529,824; 6,542,795; 6,587,758; 6,587,759; 6,703,944** **DEMAND FOR JURY TRIAL**

Plaintiff AMERICAN CALCAR INC. hereby complains of Defendant BMW OF NORTH AMERICA, LLC, and alleges as follows:

JURISDICTION AND VENUE

1. This action for patent infringement arises under the patent laws of the United States, Title 35, United States Code, more particularly, 35 U.S.C. §§ 271 and 281.

2. This Court has subject matter jurisdiction under 28 U.S.C. §§ 1331 and 1338(a).

3. Venue is proper in this judicial district under 28 U.S.C. §§ 1391(c) and 1400(b).

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